

Remarks

By this Amendment, claims 32 to 38 and 55 to 56 have been cancelled without prejudice or disclaimer and new claims 57 to 69 have been added. Applicants submit that no new prohibited matter has been introduced by the amendment to the claims. While written description support for the substitute claims can be found throughout the specification and in the original claims, examples of specific support for the additional claims can be found in the specification beginning on page 14, line 29 thru page 15, line 32 and in original claims 32 to 38.

Summary of Advisory Office Action

1. The rejection of claims 32 to 38 and 55 to 56 under 35 U.S.C. 112 was maintained in part, and withdrawn in part. The part of the rejection based on new matter for the term “at least ten” was maintained while the part of the rejection based upon new matter for the term “software” was withdrawn.

2. The rejection of claims 32 to 38 and 55 to 56 under 35 U.S.C. 103 as being unpatentable in view of Maslyn *et al.* was maintained.

Rejection under 35 U.S.C. 112

In the advisory Office Action dated March 30, 2005 the Examiner maintained that Applicants have failed to comply with the written description requirement because claims 32 to 38 and 55 to 56 purportedly contain new matter. The Examiner purports that the specification does not have adequate written description for a computer system comprising a database containing information concerning the expression levels of at least ten, fifty or seventy different nucleic acid molecules. Without acquiescing to the merits of the rejection, Applicants have cancelled these claims rendering the rejection moot. Applicants bring to the attention of the Examiner that the substitute claims are directed up to a computer system with statistical values for at least ten nucleic acid molecules in the experimental data set for which written support can be found in the specification on page 3, lines 26 to 29.

Rejection under 35 U.S.C. 103

In the advisory Office Action, the Examiner maintained the rejection of claims 32 to 38 and 55 to 56 under 35 U.S.C. 103(a) as being unpatentable over Maslyn *et al.* (U.S. Patent 5,953,727). The Office Action purports that the sequence and data expression levels recited in the claims do not have a functional relationship with the hardware recited in the claims and as such, they purportedly do not distinguish the

claims from the cited reference. Without acquiescing to the merits of the rejection, Applicants have cancelled these claims rendering the rejection moot.

With regard to the substitute claims, Applicants bring to the attention of the Examiner that the substitute claims now require the presence of a (1) user interface for inputting statistical values which relate to the expression of nucleic acid molecules in an experimental sample, and (ii) software means for generating a second experimental data set which comprises statistical values which are a measure of the correlation of expression of selected nucleic acid molecules associated with BPH. Applicants submit that the claimed computer system requires the presence of means for entering data (*i.e.*, user interface for entering statistical values associated with the expression of the specified nucleic acid molecules) and a means for transforming this data (*i.e.*, software to generate a second experimental data set which contains statistical values which correlate to the presence or absence of BPH) to provide a functional interrelationship between the computer system and the software which permits the computer system's functionality to be realized. As such, Applicants submit that the expression information associated with each nucleic acid molecule constitutes functional descriptive matter which distinguishes the claimed computer system from the disclosure in the cited reference.

Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request reconsideration and timely allowance of the pending claim. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at her convenience.

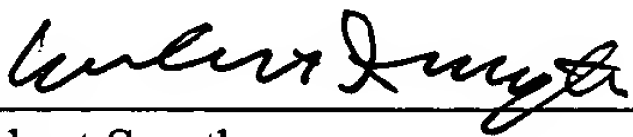
Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit

any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. 1.136(a)(3).

Dated: **August 8, 2005**

Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Ave., N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted
Morgan, Lewis & Bockius LLP



Robert Smyth
Registration No. 50,801